



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/094,949 06/15/98 MERRIMAN

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TM02/0731

EXAMINER

HARLE, J

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/094,949

Applicant(s)

MERRIMAN ET AL.

Examiner

Jennifer I. Harle

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-84 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 63-84 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claims 1-62 were previously pending and have been canceled pursuant to applicant's response. New claims 63-84 have been added and examined in this action. New claims 63-84 have been rejected. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Remarks

Applicants submit that each claim is patentably distinguishable over Kohda, Wexler, Angles, and Minor because they fail to disclose a system or method for selecting an online advertisement based upon feedback pertaining to that advertisement's performance with respect to an advertiser Web site. Applicants define feedback on performance at the paragraph spanning pages 16-17. The examiner has carefully reviewed this section and found no definition of feedback on performance. Therefore, the examiner has interpreted feedback on performance in light of the following passage: "Some of the decisions that the predictive model bases its advertisement selection include user characteristics, past exposure to the advertisement, historical statistical performance in the context of the user and the event; and/or the payment rate for the offer." Some is defined by Webster's Third New International Dictionary as some one: one person or thing among a number. Thus, applicant's arguments that each claim is patentably distinguishable over Kohda, Wexler, Angeles, and Minor under 35 U.S.C. § 102 is not persuasive.

Applicant argues that the examiner has not established a *prima facie* case of obviousness, because the suggestions or motivations provided by the Examiner do not cure the deficiencies of Kodha, Wexler, Angles, and Minor (the 35 U.S.C. § 102 art). It appears that applicant is arguing that the references are missing certain elements and therefore no combination of the references would result in applicant's invention. As discussed above, applicant's arguments pertaining to the 102 art was not persuasive and as shown below all elements are present.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 63, 66, 70, 73, 77, 80, and 84 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohda.

As per claim 63 Kohda teaches, a method for online advertising selection (pg. 1493 - Abstract), comprising:

(a) receiving feedback on performance of each of a plurality of online advertisements with respect to an advertiser Web site (pg. 1494-1495: feedback includes user characteristics see remarks above);

(b) receiving a request to display an online advertisement to a user (pg. 1495 –
2.2 Delivering advertisements to customers); and

(c) selecting, in response to the request, one of the plurality of on online
advertisements for display based on the performance feedback (pg. 1495 - 2.2
Delivering advertisements to customers – the advertising agent can tailor
advertisements for individuals and their current interests).

Claim 66 is rejected for the same reason set forth in claim 63 above.

The system claim 70 is rejected for the same reasons set forth in claim 63 above.

The system claim 73 is rejected for the same reasons set forth in claim 66 above.

The medium claim 77 is rejected for the same reasons set forth in claim 63
above.

The medium claim 80 is rejected for the same reasons set forth in claim 66
above.

The method claim 84 is rejected for the same reasons set forth in claim 63. See
remarks section above and definition of some.

2. Claims 63, 66, 70, 73, 77, 80, and 84 are rejected under 35 U.S.C. 102(e) as
being anticipated by Angeles, U.S. Patent No. 5,993,811.

As per claim 63 Angeles teaches, a method for online advertising selection
(Abstract), comprising:

(a) receiving feedback on performance of each of a plurality of online
advertisements with respect to an advertiser Web site (Abstract);

(b) receiving a request to display an online advertisement to a user (Abstract);
and

(c) selecting, in response to the request, one of the plurality of on online advertisements for display based on the performance feedback (Abstract).

The system claim 70 is rejected for the same reasons set forth in claim 63 above.

The medium claim 77 is rejected for the same reasons set forth in claim 63 above.

The method claim 84 is rejected for the same reasons set forth in claim 63. See remarks section above and definition of some.

As per claim 66, Angeles teaches that the performance feedback includes characteristics of users to which the plurality of online advertisements are displayed (Col. 3, lines 58-62; Col. 8, lines 55-61; Col. 8, lines 55-62; Col. 14, lines 17-26).

The system claim 73 is rejected for the same reasons set forth in claim 66 above.

The medium claim 80 is rejected for the same reasons set forth in claim 66 above.

3. Claims 63-68, 70-75, 77-82 and 84 are rejected under 35 U.S.C. 102(e) as being anticipated by March, et al., U.S. Patent No. 5,848, 397.

As per claim 63 Marsh, et al. teaches, a method for online advertising selection (Abstract), comprising:

(a) receiving feedback on performance of each of a plurality of online advertisements with respect to an advertiser Web site (Abstract; column 4, lines 30-40);

(b) receiving a request to display an online advertisement to a user (column 5; lines 6-21; column 7, lines 7-38); and

(c) selecting, in response to the request, one of the plurality of on online advertisements for display based on the performance feedback (column 5, lines 14-18; columns 8-13).

The system claim 70 is rejected for the same reasons set forth in claim 63.

The medium claim 77 is rejected for the same reasons set forth in claim 63.

The method claim 84 is rejected for the same reasons set forth in claim 63. It's "predictive model" is the scheduling criteria used and includes some of the same decisions upon which applicant's predictive model bases its decisions, i.e. user characteristics, past exposures, historical performance, and payment rate for the offer. See rejected dependent claims 64-67.

As per claim 64, Marsh teaches that the performance feedback can include a historical statistical conversion rate of each of the plurality of online advertisements (column 4, lines 32-40).

The system claim 71 is rejected for the same reasons set forth in claim 64.

The medium claim 78 is rejected for the same reasons set forth in claim 64.

As per claim 65, Marsh teaches that the performance feedback includes a cost per action of each of the plurality of online advertisements (column 4, lines 3-6).

The system claim 72 is rejected for the same reasons set forth in claim 65.

The medium claim 79 is rejected for the same reasons set forth in claim 65.

As per claim 66, Marsh teaches that the performance feedback includes characteristics of users to which the plurality of online advertisements are displayed (column 3, lines 11-27).

The system claim 73 is rejected for the same reasons set forth in claim 66.

The medium claim 80 is rejected for the same reasons set forth in claim 66.

As per claim 67, Marsh teaches that the performance feedback includes a number of times each of the plurality of online advertisements is displayed to users (column 4, lines 33-35).

The system claim 74 is rejected for the same reasons set forth in claim 67.

The medium claim 81 is rejected for the same reasons set forth in claim 67.

As per claim 68, Marsh teaches that the performance email is received via e-mail (column 8, lines 12-15).

The system claim 75 is rejected for the same reasons set forth in claim 68.

The medium claim 82 is rejected for the same reasons set forth in claim 68.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 64-65, 67-68, 71-72, 74-75, 78-79 and 81-82 rejected under 35

U.S.C. 103(a) as being unpatentable over Kohda, et al..

As per claim 64, Kohda teaches as discussed above in claim 63. Kohda does not specifically disclose that the performance feedback includes a historical statistical conversion rate. However, Kohda, et al. does disclose recording the actions of users in relation to a particular advertisement (i.e., reading its details or buying the goods or services, historical statistics on these transactions) in order to prove the effectiveness of the advertising agent (pg. 1498, col. 2, Section 4). This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area. It would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a historical statistical conversion rate as performance feedback in order to prove effectiveness of the advertising to the advertiser and other potential clients to make the advertising agent more competitive and profitable.

The system claim 71 is rejected for the same reasons set forth in claim 64 above.

The medium claim 78 is rejected for the same reasons set forth in claim 64 above.

As per claim 65, Kohda does not specifically disclose that the performance feedback includes a cost per action of each of the plurality of on line advertisements. However, this pricing model is well known in the art, i.e. CPA pricing. See Applicant's Specification, Background Section, pg. 2. It would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the cost per action as a form of performance feedback because it enables the advertising agent to fulfill the display rate contracted with the advertiser thereby promoting goodwill and client

satisfaction as well as enhancing the competitiveness of the advertising agent by being able to show the clients the success of the ads being targeted.

The system claim 72 is rejected for the same reasons set forth in claim 65 above.

The medium claim 79 is rejected for the same reasons set forth in claim 65 above.

As per claim 67, Kohda does not specifically teach that the performance feedback includes the number of times each of the plurality of online advertisements is displayed to users. However, Kohda, et al. does disclose that an advertising agent must have a good strategy to beat the competition, one of which is not delivering the advertisements continuously (pg. 1498 Section 2.4 Competition Between Advertising Agents.). Moreover, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the number of times an advertisement was displayed to users because it would enable rotation of the advertisement, which would in turn alleviate consumer boredom with the ad and tuning the ad out as well as enabling the advertising agent to fulfill the display rate contracted with the advertiser thereby promoting goodwill and client satisfaction as well as enhancing the competitiveness of the advertising agent by being able to show the clients the success of the ads being targeted.

The system claim 74 is rejected for the same reasons set forth in claim 67 above.

The medium claim 81 is rejected for the same reasons set forth in claim 67 above.

As per claim 68, Kohda does not teach that the performance feedback is received via e-mail. However, email is a well-known method of feedback. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select email as the feedback signal as e-mail is a faster and economical method of communication.

The system claim 75 is rejected for the same reasons set forth in claim 68 above.

The medium claim 82 is rejected for the same reasons set forth in claim 68 above.

5. Claims 64-65, 67, 71-72, 74 78-79 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angeles, et al..

As per claim 64, Angeles teaches as discussed above in claim 63. Angeles does not specifically disclose that the performance feedback includes a historical statistical conversion rate. However, Angeles does teach storing historical results of previous placements of said plurality of direct advertisements in said advertising medium (Cols. 15-16, lines 56-7) including a predictive model for selecting one of said plurality of advertisements based on said historical results (Fig. 4 – Consumer Computer; Col. 7, lines 52-60); and a feedback signal to said advertisement server providing the historical results of previous placements and of any transaction between said user and said selected advertiser (Cols. 3-4, lines 65-16; Cols. 15-16, 55-7). This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area. It would have been obvious for one of ordinary skill in the art at the time the invention was made to compile

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the statistics in order to select the advertisement in order to more effectively fulfill the display rate contracted with the advertiser and thus making the advertising agent more competitive.

The system claim 71 is rejected for the same reasons set forth in claim 64 above.

The medium claim 78 is rejected for the same reasons set forth in claim 64 above.

As per claim 65, Angeles does not specifically disclose that the performance feedback includes a cost per action of each of the plurality of on line advertisements. However, this pricing model is well known in the art, i.e. CPA pricing. See Applicant's Specification, Background Section, pg. 2. It would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the cost per action as a form of performance feedback because it enables the advertising agent to fulfill the display rate contracted with the advertiser thereby promoting goodwill and client satisfaction as well as enhancing the competitiveness of the advertising agent by being able to show the clients the success of the ads being targeted.

The system claim 72 is rejected for the same reasons set forth in claim 65 above.

The medium claim 79 is rejected for the same reasons set forth in claim 65 above.

As per claim 67, Angeles does not specifically teach that the performance feedback includes the number of times each of the plurality of online advertisements is displayed to users. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it

would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the number of times an advertisement was displayed to users because it would enable rotation of the advertisement, which would in turn alleviate consumer boredom with the ad and tuning the ad out as well as enabling the advertising agent to fulfill the display rate contracted with the advertiser thereby promoting goodwill and client satisfaction as well as enhancing the competitiveness of the advertising agent by being able to show the clients the success of the ads being targeted.

The system claim 74 is rejected for the same reasons set forth in claim 67 above.

The medium claim 81 is rejected for the same reasons set forth in claim 67 above.

6. Claims 69, 76 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. as applied to claim 63, 70 and 77 above, and further in view of the Microsoft Press Computer Dictionary Third Edition, 1997, pg. 387.

As per claim 69, Kohda does not teach that the performance feedback is received via a proxy server. However, Kohda does teach the use of a proxy server as part of a filter, agent to user and agent to advertiser, with a ubiquitous advertising on the web and merging advertisements on browsers. Pg. 1498, Section 3.3. A proxy server acts as a firewall component that manages internet traffic to and from a LAN ...and can improve performance by supplying frequently requested data ... and can filter and discard requests the owner does not consider appropriate, such as requests for unauthorized access to proprietary files. Microsoft Dictionary, pg. 387. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

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method of online advertisement selection as taught by Marsh, et al. to include the proxy server of Kohda, et al. because proxy servers clearly protect the integrity of the advertising agent and advertisers networks. Steps to enhance the security and integrity of a client's or a business's systems represent an obvious modification to the prior process taught by Kohda, et al.

The system claim 76 is rejected for the same reasons set forth in claim 69.

The medium claim 83 is rejected for the same reasons set forth in claim 69.

7. Claims 69, 76 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh, et al. as applied to claim 63, 70, and 77 above, and further in view of Kohda, et al. and the Microsoft Press Computer Dictionary Third Edition, 1997, pg. 387.

Marsh, et al. teaches as discussed above in claim 63. Marsh, et al. does not expressly show the performance feedback being received via a proxy server. Kohda, et al. teaches the use of a proxy server as part of a filter, agent to user and agent to advertiser, with a ubiquitous advertising on the web and merging advertisements on browsers. Pg. 1498, Section 3.3. A proxy server acts as a firewall component that manages internet traffic to and from a LAN ...and can improve performance by supplying frequently requested data ... and can filter and discard requests the owner does not consider appropriate, such as requests for unauthorized access to proprietary files. Microsoft Dictionary, pg. 387. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of online advertisement selection as taught by Marsh, et al. to include the proxy server of Kohda, et al. because

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proxy servers clearly protect the integrity of the advertising agent and advertisers networks. Steps to enhance the security and integrity of a client's or a business's systems represent an obvious modification to the prior process taught by Marsh, et al.

The system claim 76 is rejected for the same reasons set forth in claim 69.

The medium claim 83 is rejected for the same reasons set forth in claim 69.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:00 a.m. to 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703.308.5357 for regular communications and 703.308.5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

jih
July 27, 2001


TARIQ R. HAFIZ
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